

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTTI ILMARINEN

Appeal No. 1997-3816
Application No. 08/512,313

ON BRIEF

Before CALVERT, ABRAMS, and MCQUADE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-3, 5, 6, 8-20, 41 and 42, which at that point constituted all of the claims remaining of record in the application.

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The appellant's invention is directed to a press section of a paper machine. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Laapotti (Laapotti '682) 18, 1986	4,576,682	Mar.
Ilmarinen et al. (Ilmarinen) 20, 1990	4,909,905	Mar.
Dahl 10, 1990	4,915,790	Apr.
Laapotti (Laapotti '762) 24, 1990	4,919,762	Apr.
Karvinen et al. (Karvinen) 1990	4,931,143	Jun. 5,
Laapotti (Laapotti '046) 27, 1991	5,043,046	Aug.
Bluhm et al. (Bluhm) 1991	5,071,513	Dec. 10,

Mirsberger - "Shoe Presses For Intensive Dewatering Of Paper And Board," Das Papier, vol. 43, pp. 130-138, Oct. 1989
(Mirsberger)¹

The prior art admitted by the appellant on page 6 of the specification (see Examiner's Answer, page 5).

¹Our understanding of this reference was obtained by means of a PTO translation, a copy of which is enclosed.

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THE REJECTIONS

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 1-3, 5, 6, 8, 14-18, 41 and 42 on the basis of Laapotti '762 and Mirsberger.
- (2) Claim 13 on the basis of Laapotti '762, Mirsberger and Ilmarinen.
- (3) Claims 9-11 and 19 on the basis of Laapotti '762, Mirsberger and either the admitted prior art or Laapotti '046 or Dahl.
- (4) Claims 12 and 20 on the basis of Laapotti '762, Mirsberger and Bluhm.
- (5) Claim 41 on the basis of Laapotti '762, Mirsberger, Karvinen or Ilmarinen.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant, we make reference to the Examiner's Answer (Paper No. 16) and to the Appellant's Brief (Paper No. 15).

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the

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Brief. As a result of our review, we have determined that none of the examiner's rejections should be sustained. Our rationale for arriving at this conclusion follows.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings

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to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal ,Inc. V. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988).

Apparatus claim 1 is directed to a press section of a paper machine including a plurality of press rolls and a pick-up roll which, from our perspective, is exemplified in the prior art by Laapotti '762, the primary reference. Among the elements recited in claim 1 is a hollow-faced press roll situated against the suction zone of the press pick-up roll to form a first press nip after the web is transferred to a pick-up felt, with the first press nip being structured and arranged to provide a low load, and an extended nip means after the first press nip in the running direction of the web, with the extended nip means comprising a smooth-faced press

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roll and constituting the only press nip formed against the smooth-faced center roll. It is the examiner's view that Laapotti '762 discloses all of the subject

matter recited in claim 1 except for the use of two conventional press nips on the second press roller rather than the single extended nip. However, the examiner takes the position that one of ordinary skill in the art would have been taught by Mirsberger that a single extended nip press can take the place of a plurality of conventional nip presses, and therefore would have found it obvious to modify the machine of Laapotti '762 by replacing the two conventional nip presses labeled as N_2 and N_3 in Figure 1 with a single extended nip press. The appellant disputes this conclusion, urging that Mirsberger is not entitled to so broad an interpretation.

As we understand the examiner's position, it is that by virtue of one sentence in the summary and the representations in two of the Figures, one of ordinary skill the art would have found it obvious to replace any pair of conventional nip presses with a single extended nip press (see Answer, pages 4 and 6-8). We find this stance not to be supported in the reference. In the summary section of the reference (PTO translation, page 2), the following two sentences appear, seriatim:

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In comparison with roll presses, the pressure increase is slower in a shoe press, therefore, this press is suitable for the first press position (emphasis added). It can replace several conventional type press nips due to its high dewatering performance.

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The examiner has grounded the rejection upon the second sentence only. From our perspective, however, to look to the second sentence without the first, as the examiner has done, is to take it out of context. Our review of the entire document failed to find another portion of the text that supported the very broad interpretation of the teachings espoused by the examiner in the rejection and, in particular, we find the diagrammatic presentations provided in Figures 9 and 23 to be so lacking in detail and accompanying explanation as to fall short of providing such support.

Furthermore, we point out that in Laapotti '762, while pick-up felt 20 carries the web through press nip N_1 and through press nip N_2 , which is the first of the pair of conventional press nips which the examiner proposes to replace with a single extended press nip, it does not carry the web through press nip N_3 , the second of the two press nips that the examiner would replace. The web is carried through press nip N_3 by a second pick-up felt 50. This being the case, replacement of press nips N_2 and N_3 with a single extended press nip would necessitate the elimination of pick-up felt 50, for the appellant's claim 1

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recites but a single pick-up felt (line 3), and requires that
it carry the web through the first press nip (lines 6 and 7)
and the extended nip means (lines 11 and 12), and that it
constitute the

only water-receiving press fabric in the extended nip (lines 14 and 15). In our view, elimination of pick-up felt 50 would greatly alter the structure and operation of the Laapotti '762 system, to the extent that it would serve as a disincentive to the artisan to make the change proposed by the examiner.

Thus, the teachings of Laapotti '726 and Mirsberger, combined on the bases advanced by the examiner, fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in independent claim 1. This also applies to independent apparatus claim 42, which sets forth the invention in slightly different terms but contains the same limitations, and to independent method claim 14, in which the steps establish these same limitations.

We therefore will not sustain the rejection of claims 1-3, 5, 6, 8, 14-18, 41 and 42.

The examiner's other four rejections of the various dependent claims all rely upon Laapotti '762 and Mirsberger combined in the same manner. The additional references cited in these rejections fail to alleviate the shortcomings we have discussed above, and thus we also will not sustain the examiner's rejections of claims 9-13, 19, 20 and 41.

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SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JOHN P. MCQUADE)	
Administrative Patent Judge)	

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Prepared: April 25, 2001